

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-16 and 24-29 are pending in this case. Claim 1 is amended by the present amendment. As amended Claim 1 is supported by the original disclosure,<sup>1</sup> no new matter is added.

In the outstanding Official Action, Claims 1, 2, 6, 9-11, 13, and 25 were rejected under 35 U.S.C. §103(a) as unpatentable over Alexander et al. (U.S. Patent No. 6,177,931, hereinafter “Alexander”) in view of Picco et al. (U.S. Patent No. 6,029,045, hereinafter “Picco”) and Danneels et al. (U.S. Patent No. 5,805,825, hereinafter “Danneels”); Claim 3 was rejected under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco and Danneels and further in view of Hölzle et al. (U.S. Patent No. 5,970,249, hereinafter “Hölzle”); Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco and Danneels and further in view of Winston (U.S. Patent No. 6,434,653); Claim 7 was rejected under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco and Danneels and further in view of Russo (U.S. Patent No. 5,619,247); Claim 8 was rejected under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco and Danneels and further in view of Kostreski et al. (U.S. Patent No. 5,729,549, hereinafter “Kostreski”); Claims 12, 24, 26, 28, and 29 were rejected under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco and Danneels and further in view of Trovato (U.S. Patent No. 6,701,526); and Claims 14-16 were rejected under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco and Danneels and further in view of Inoue et al. (U.S. Patent Publication No. 2002/0016963 A1, hereinafter “Inoue”).

---

<sup>1</sup>See, e.g., the specification at page 4, lines 4-6 and page 11, lines 4-7.

Initially, Applicants and Applicants' representatives thank Examiners Beliveau and Sheleheda for the courtesy of the interview granted to Applicants' representatives on March 28, 2007. During the interview, differences between the claims and Alexander and Picco were discussed. Examiners Beliveau and Sheleheda agreed that a proposed amendment to Claim 1 appeared to overcome the rejections of record. This proposed amendment to Claim 1 is presented herewith.

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Alexander in view of Picco, that rejection is respectfully traversed.

Amended Claim 1 recites in part:

a memory configured to store all of the current plurality of sets of the broadcast data service data; the broadcast data service data defining a plurality of digital audio/video data sets, ***the digital audio/video data sets including television clips;***  
***a display configured to provide a list of a plurality of sets of the digital audio/video data sets;*** and  
a controller responsive to a user initiated selection signal to cause the memory to ***output a user selected one of the plurality of digital audio/video data sets selected from the list*** simultaneously with continued receipt of the broadcast digital television data, the selected one of the broadcast data service data plurality of sets having digital audio/video data in non-real time, the selection signal being provided at any time during receipt of the broadcast digital television data and independently of the broadcast digital television data and the controller is responsive at any time during receipt of the broadcast digital television data and independently of the broadcast digital television data to output said selected portion.

Alexander describes an electronic program guide with which a main television stream can be watched, for instance in the PIP window 12, simultaneously with advertisements, for instance in ad windows 14 or 16.<sup>2</sup> Other television programs currently being aired can be selected in the grid guide 22. Thus, grid guide 22 of Alexander is a list of television programs currently being aired, ***not*** a list of digital audio/video data sets including television

---

<sup>2</sup>See Alexander, Figure 1.

clips that can be selected by a user and output by a controller. Thus, Alexander does not teach or suggest “a display” as defined in amended Claim 1.

Further, the outstanding Office Action cited the circuit board described in column 5, lines 21-28 of Alexander as “a controller” as recited in Claim 1.<sup>3</sup> However, it is respectfully noted that Alexander does not describe that this circuit board is configured to output a user selected one of a plurality of digital audio/video data sets selected from a displayed list simultaneously with continued receipt of the broadcast digital television data, as Alexander does not describe a display providing such a list. Thus, the circuit board described in column 5, lines 21-28 of Alexander is not “a controller” as defined in amended Claim 1.

Further, Picco describes adding local content to a broadcast stream, and thus is not concerned either with broadcast data service as recited in Claim 1 or an EPG as described by Alexander. Specifically, Picco does not teach or suggest a display configured to provide a list of a plurality of sets of the digital audio/video data sets including television clips, or a controller configured to output a user selected one of a plurality of digital audio/video data sets selected from a displayed list simultaneously with continued receipt of the broadcast digital television data. Thus, Picco does not teach or suggest “a display” or “a controller” as defined in amended Claim 1 either.

Finally, Danneels describes a data carousel for automatically repeatedly transmitting data. It is respectfully submitted that Danneels does not teach or suggest a display configured to provide a list of a plurality of sets of the digital audio/video data sets including television clips, or a controller configured to output a user selected one of a plurality of digital audio/video data sets selected from a displayed list simultaneously with continued receipt of the broadcast digital television data. Thus, Danneels does not teach or suggest “a display” or “a controller” as defined in amended Claim 1 either.

---

<sup>3</sup>See the outstanding Office Action at page 3, lines 21-23.

Consequently, as Alexander, Picco, and Danneels do not teach each and every element of amended Claim 1, Claim 1 (and Claims 2-16 and 24-29 dependent therefrom) is patentable over Alexander in view of Picco and Danneels.

With regard to the rejection of Claim 3 as unpatentable over Alexander in view of Picco and Danneels and further in view of Hölzle, it is noted that Claim 3 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Hölzle does not cure any of the above-noted deficiencies of Alexander, Picco, and Danneels. Accordingly, it is respectfully submitted that Claim 3 is patentable over Alexander in view of Picco and Danneels and further in view of Hölzle.

With regard to the rejection of Claims 4 and 5 as unpatentable over Alexander in view of Picco and Danneels and further in view of Winston, it is noted that Claims 4 and 5 are dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Winston does not cure any of the above-noted deficiencies of Alexander, Picco, and Danneels. Accordingly, it is respectfully submitted that Claims 4 and 5 are patentable over Alexander in view of Picco and Danneels and further in view of Winston.

With regard to the rejection of Claim 7 as unpatentable over Alexander in view of Picco and Danneels and further in view of Russo, it is noted that Claim 7 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Russo does not cure any of the above-noted deficiencies of Alexander, Picco, and Danneels. Accordingly, it is respectfully submitted that Claim 7 is patentable over Alexander in view of Picco and Danneels and further in view of Russo.

With regard to the rejection of Claim 8 as unpatentable over Alexander in view of Picco and Danneels and further in view of Kostreski, it is noted that Claim 8 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Kostreski does not cure any of the above-noted deficiencies of Alexander, Picco, and Danneels. Accordingly, it is respectfully submitted that Claim 8 is patentable over Alexander in view of Picco and Danneels and further in view of Kostreski.

With regard to the rejection of Claims 12, 24, and 26 as unpatentable over Alexander in view of Picco and Danneels and further in view of Trovato, it is noted that Claims 12, 24, and 26 are dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Trovato does not cure any of the above-noted deficiencies of Alexander, Picco, and Danneels. Accordingly, it is respectfully submitted that Claims 12, 24, and 26 are patentable over Alexander in view of Picco and Danneels and further in view of Trovato.

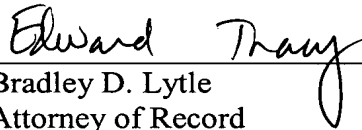
With regard to the rejection of Claims 14-16 as unpatentable over Alexander in view of Picco and Danneels and further in view of Inoue, it is noted that Claims 14-16 are dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Inoue does not cure any of the above-noted deficiencies of Alexander, Picco, and Danneels. Accordingly, it is respectfully submitted that Claims 14-16 are patentable over Alexander in view of Picco and Danneels and further in view of Inoue.

Application No. 09/630,971  
Reply to Office Action of December 18, 2006

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Edward Tracy  
Registration No. 47,998

I:\ATTY\ET\282622US\282622US-AMD4.18.07.DOC